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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,885	01/22/2002	Jose Duez	BDL-364XX	5084
207	7590	12/15/2003	EXAMINER	
WEINGARTEN, SCHURGIN, GAGNEBIN & LEOVICI LLP TEN POST OFFICE SQUARE BOSTON, MA 02109			NGUYEN, TUAN N	
			ART UNIT	PAPER NUMBER

3751

DATE MAILED: 12/15/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/009,885

Applicant(s)

DUEZ ET AL.

Examiner

Tuan N. Nguyen

Art Unit

3751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claims 6 is objected to because of the following informalities: the limitation "the elongate element is constituted of sintered microbeads" in line 2 is inaccurate since lines 1-5 of claim 1 is indicating that the elongate element is constituted of "fibers" that are held together by sintered microbeads. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation "fibers juxtaposed" in line 4 of claim 1 and line 7 of claim 14 has not been disclosed in the original disclosure; therefore, it is considered to be new matter and "juxtaposed" should be taken out of claims 1 and 14.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 1, it is unclear as to whether the "sintered microbeads" in line 5 is the "binder" (see lines 7-8 of claim 14) or is a different alternative form of the "binder" as claimed in line 5 of claim 1. In that respect, it is unclear as to what the limitation "the elongate element is constituted of sintered microbeads" in line 2 of claim 6 is trying to claim.

With respect to claim 3, it is unclear as to the difference between the "sealing agent in line 2 and the "binder" in line 5 of claim 1 (see also claim 8).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Hori.

Hori discloses a nib constituted of a segment of a coherent, elongated rod/element of high porosity polyester fiber material (10) having a diameter lying in the range of 2 mm to 15 mm (see col. 7, line 4 et seq.), with at least a first end shaped to form a writing tip (see Figs. 1a-5b). The material includes pores or capillaries blocked over a limited thickness lies in the range of 0.01 mm to 1 mm (see col. 7, line 17 et seq.), which inherently would create an airtight barrier, with the exception of the first end the allow capillaries ink to be applied on a writing surface. A sealing agent (18) of synthetic resin such as epoxy resin, urethane resin, or phenolic resin blocks the pores or capillaries. The resin being claimed in claims 4, 5, and 9 are inherently another form of the above synthetic resin. The elongated element would constituted of "sintered microbeads" since it is being molded or thermal shock under temperature lying in the range of 200°C to 300°C for a period of 10 to 50 seconds (see col. 3, line 50 et seq. and col.

7, lines 18-23). The method as claimed would be inherent during normal manufacture of the Hori nib. The Hori nib would be inherently used on writing implement as claimed in claim 14 (see col. 1, line 1 et seq.).

5. As best understood, claims 1-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson.

The Johnson reference would also be applied in a similar fashion as the Hori reference.

Response to Arguments

6. Applicant's arguments filed November 10, 2003 have been fully considered but they are not persuasive.

The Examiner disagrees with the Applicant's assertion in line 14 of page 8 through line 16 of page 11. Contrary to Applicant's speculation, the Hori clearly indicates that the filament rod-shaped body (15), once formed, is then being impregnated with the liquid resin in a liquid resin bath (16) which is similar to Applicant's treatment bath (6); after that, the combination of the rod-shaped body (15) impregnated with liquid epoxy resin pass through a dielectric heating pipe/chamber (22). The Hori reference clearly indicates that the "resin content in the liquid resin becomes quickly gelled" (see col. 4, lines 59-61). The Hori reference further indicates in lines 12-26 of column 5 that "various states of resin solidification can be determined very easily by empirically setting the dial for the output adjustment" (see col. 4, lines 24-26). The solidified resin would form a sealing about the fiber core and therefore would inherently create an airtight barrier. Once the Hori fiber rod-shaped nib is cut to form a writing tip, the elongate filament element is exposed and allowed ink flow therethrough. The Applicant is reminded that the usefulness or workmanship of the Hori reference device has no bearing in the rejections of structural and method of the claimed invention.


Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Fernandez discloses another felt tip with protective shield, which inherently would act as a barrier to prevent ink from evaporating.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan N. Nguyen whose telephone number is 703-306-9046. The examiner can normally be reached on Monday-Friday (10:00-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory L. Huson can be reached on 703-308-2580. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-872-9301.


Tuan N. Nguyen
Primary Examiner
Art Unit 3751
12/10/07

TN